

REMARKS

Claims 54-64 and 69-107 are pending and Claims 54 and 58-64 have been rejected. Claims 55-57 and 69-107 have been withdrawn. Claims 1-53 and 65-68 have been canceled.

I. Double Patenting

The Examiner has provisionally rejected Claims 54 and 58-64 on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claim 67 of copending U.S. Patent Application No. 10/912,948. The Examiner has provisionally rejected Claims 54 and 58-64 on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 139-304 of copending U.S. Patent Application No. 11/130,922. The Examiner has provisionally rejected Claims 54 and 58-64 on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 61-64 of copending U.S. Patent Application No. 10/830,898. The Examiner has rejected Claims 54 and 58-64 on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claim 23-33 and 42-44 of U.S. Patent No. 6,365,616. Applicants note that they will file a Terminal Disclaimer (and filing fee) assuring that the present application and copending Application Nos. 10/912,948; 11/130,922; and 10/830,898 and US Patent No. 6,365,616 will expire at the same time if conflicting claims are issued. The filing of this Terminal Disclaimer should render moot the above-referenced double patenting rejections.

II. 35 U.S.C. § 102

The Examiner rejected claims 54 and 58-64 under 35 USC 102(b) as being anticipated by Kohn (US Patent No. 6,365,616). Applicant traverses the rejection for at least the reasons asserted in earlier responses and the reasons set forth below.

According to the Examiner, “Kohn teaches the administration of 5-methyl methimazole to treat autoimmune diseases such as systemic lupus erythromatosus, characterized by a potentially cardiovascular disorder.... According to The Merck Manual, which is present for evidentiary purposes only, noninfective endocarditis is a cardiovascular disease that occurs in a certain population of patients having systemic lupus erythromatosus.” Applicants strongly disagree that Kohn teaches systemic lupus erythromatosus, “characterized by a potentially cardiovascular disorder.” Kohn teaches treatment of systemic lupus erythromatosus (“SLE”), but never even mentions cardiovascular disorders, and never characterizes SLE as a cardiovascular disorder.

Further, the Examiner incorrectly relies on inherent anticipation in this rejection. The prior art can only inherently anticipate when "a previously patented device, **in its normal and usual operation**, will perform the function which an applicant claims in a subsequent application for a process patent, then such application for a process patent will be considered to be anticipated by the former patented device." In re: King, 801 F.2d 1324, 1326 (Fed. Cir. 1986) [emphasis added]; See also Atlas Powder Co. v. Ireco, Inc., 190 F. 3d 1342, 1347-48 (Fed. Cir. 1999); and Mehl/Biophile Int'l Corp., v. Milgraum, 1999 U.S. App. LEXIS 301386 (Fed. Cir. Oct. 27, 1999). Even the case cited by the Examiner requires “a necessary feature or result of a prior art embodiment” for inherent anticipation. Schering Corp. v. Geneva Pharm., Inc., 339 F.3d 1373, 1377 (Fed. Cir. 2004). Here, the Merck Manual cited by the Examiner states, “In SLE [systemic lupus erythromatosus], friable platelet and fibrin vegetation **may** develop along a valve leaflet closure. At autopsy, **40%** of SLE patients dying of active disease have lesions on one or more valves.” (emphasis added). Clearly the art in teaching that there are numerous SLE patients who do **not necessarily** have this cardiovascular disorder, and 60% of SLE dying of active disease do

not have it. Therefore, it **cannot** be said that SLE patients necessarily or inherently have cardiovascular disorders, in fact the majority, do **not**. Accordingly, Kohn's teaching of treatment of SLE with 5-methyl methimazole is not an inherent treatment of cardiovascular disorders, since most SLE patients do not have cardiovascular disorders. Applicant asserts that this rejection has been overcome.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests consideration and allowance of the pending claims. Finally, Applicant respectfully requests a courtesy of a phonecall in order to resolve any outstanding issues.

Authorization of Deposit Account

The Commissioner is hereby authorized to charge any fees which may be required during the entire pendency of this application, or credit any overpayment, to Deposit Account No. 18-0586. This authorization also hereby includes a request for any extensions of time of the appropriate length required upon the filing of any reply during the entire pendency of this application.

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Respectfully submitted,

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